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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,514	04/02/2001	Helke Lob	704018	8650

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EXAMINER

FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 05/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,514

Applicant(s)

LOB, HELKE 

Examiner

Kathryn Ferko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-14, 20 and 23 is/are rejected.
- 7) ☒ Claim(s) 6-11, 15-19, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner..

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 3, lines 22-24 reference claim 1. It is improper to reference the claims in the specification. The amendment to page 1 of the specification to correct this issue in the preliminary amendment is acknowledged.

Appropriate correction is required for this and any other occurrences in the specification.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: element 15.2. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5, 12-14 and 23 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Biedermann et al. in US Patent No. 6,168,597.

Regarding claims 1-5 and 12-14, Biedermann et al. disclose an element for fixing a first bone fragment having an elongate spreading body (21) and an elongate fixing body (2) which can be introduced into aligned bores in bone fragments and which has a proximal first portion (denoted in the area near 3), which is to be introduced into the first bone fragment, a distal second portion (denoted in the area of 6), which adjoins the first portion and which is to be introduced into the second bone fragment, and a cavity (5) which extends substantially over its length, wherein the fixing body (2) is adapted to be introduced completely into the bores, it can be spread openly transversely with respect to its longitudinal direction by a wedge action (via insertion of 21 into 2 and that via 25 due to rotation of 21) at least in the region of its two ends for connection with respect to the respective bone fragment by proximal introduction of the spreading body (21) into the cavity and after substantially complete introduction of the spreading body (21) into the cavity it is of a greater dimension

transversely with respect to its longitudinal direction at the distal end (denoted as that area closes to the area of 6) of the second portion (denoted in the area of 6) than at the proximal end (denoted in the area to the left of 6) of the second portion (denoted in the area of 6), characterized in that the fixing body (2) is adapted to be spread open substantially over its entire length, (the fixing body does spread open over its entire length as seen in figure 3, where as shown in figure 1 before the expanding member is inserted, the unexpanded position is reduced in diameter); a fixing body that has at least two body portions (that area near 3 and that area near 6 where they are distinguished by area with the slit 8 and the area without the slit 8) which adjoin each other in the peripheral direction and which are connected together movably sufficiently for spreading open, as seen in figures 1-6; operative surfaces of the fixing body and the spreading body, which co-operate for spreading open the fixing body, are of such a configuration that spreading of the second portion begins at the distal end of the second portion, as recited in column 2 and seen in figures 1-6; co-operating operative surfaces of the fixing body and the spreading body that are of such a configuration that at least one first part of the first portion (denoted in the area of 3) is spread open before the second portion is spread open (via insertion of 21); and a first part that is arranged in a region of the proximal end portion of the first portion, as seen in figure 1.

With regard to claim 23, Biedermann et al. disclose an elongate fixing body (2), sized to be introduced into the aligned bores such that a first portion

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(denoted by the area near 3) defining a proximal end thereof is introduced into the first bone fragment and a second portion (denoted in the area near 6) defining a distal end thereof is introduced into the second bone fragment, a proximal end of the second portion (the area to the left of the area around 6 where the slit 8 ends) adjoining a distal end of the first portion and the fixing body (2) has an operative surface defined by a cavity (5) extending substantially longitudinally therethrough; an elongate spreading body (21) for longitudinal introduction into the cavity at the proximal end, an operative surface of the spreading body (21) defined by an external surface thereof, the fixing body (2) operative surface and the spreading body operative surface co-acting to spread open the fixing body transversely with respect to the longitudinal direction thereof by a wedge action (via insertion of 21 into 2 and that via 25 due to rotation of 21) for connection to the respective bone fragments, such that after substantially complete introduction of the spreading body into the cavity, the second portion of the fixing body has a greater dimension transversely with respect to the longitudinal direction thereof at the distal end of the second portion than at the proximal end thereof, as seen in figures 1-6; and wherein the fixing body being adapted to be spread open substantially over its entire length, (the fixing body does spread open over its entire length as seen in figure 3, whereas shown in figure 1 before the expanding member is inserted, the unexpanded position is reduced in diameter).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biedermann et al. in US Patent No. 6,168,597.

Biedermann et al. disclose the invention as applied to claim 1 with the exception of a fixing body that is of bioresorbable material. On the other hand, bioresorbable material is well known in the art for retaining portions of bone. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Biedermann et al. to have the screw be bioresorbable for the purpose of non-permanent fixation.

Allowable Subject Matter

7. Claims 6-11, 15-19 and 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows: US Patent No. 6,506,051; US Patent No. 6,443,989; US Patent No. 6,287,310; US Patent No. 6,227,860; US Patent No. 6,142,782; US Patent No. 5,782,918; US Patent No. 5,489,210; US Patent No.

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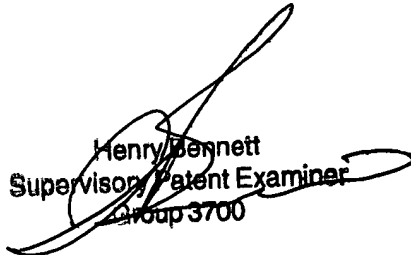
5,480,403; US Patent No. 5,470,230; US Patent No. 5,004,421; US Patent No. 2,490,364; and US Patent No. 2,381,050.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Ferko whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KF
May 13, 2003


Henry A Bennett
Supervisor, Patent Examiner
Group 3700